

### **REMARKS**

Applicants respectfully request further examination and reconsideration in view of the above amendments and arguments set forth fully below. Claims 1, 3, 5-8, and 11-13 were previously pending in the present application. Within the Office Action, Claims 1, 3, 5-8, and 11-13 have been rejected.

#### **Claim Rejections under 35 U.S.C. § 112, First Paragraph**

Within the Office Action, Claim 1 was rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. More specifically, the Examiner suggests that a step of "automatically registering identification information" is not supported in the specification. The Applicants respectfully traverse this rejection because the Applicants' disclosure is sufficient to inform those skilled in the relevant art how to both make and use a "system for controlling access to a printing environment" that involves automatically registering identification information. Indeed, the entire specification is directed at automatic network interoperability. Some particular examples of especially relevant disclosure is found on Page 5, Lines 18-21; Page 6, Lines 1-3; Page 11, Lines 9-11; Page 12, Lines 7-14; Page 12, Lines 23-24; and Page 14, Lines 13-15.

For at least these reasons, the Applicants respectfully request that the Examiner remove the rejections under 35 U.S.C. §112, first paragraph.

### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

Also within the Office Action, Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. The Applicants amend Claim 1 herein, thereby rendering the rejection moot.

### **Claim Rejections under 35 U.S.C. § 103**

Also within the Office Action, Claims 1, 3, 5-8, and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication No. 2001/0029534 to Spinks et al. (hereinafter referred to as "Spinks") in view of United States Patent Publication No. 2004/0003058 to Trossen (hereinafter referred to as "Trossen") in view of United States Patent Publication No. 2002/0133555 to Hall et al. (hereinafter referred to as "Hall") and further in view of Rendezvous.

To establish a *prima facie* case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Applicants respectfully traverse this rejection, because neither Hals nor Bollay, either alone or in combination, disclose all of the limitations of Claims 4, 5, 30, and 31.

Specifically neither Spinks, Trossen, Hall, nor Rendezvous teach or suggest "at least one handheld mobile device coupled to a wide area network (WAN); at least one printing device coupled to a local area network (LAN), wherein the LAN is configured

inside at least one firewall, wherein the directory server is configured outside the at least one firewall, wherein said at least one printing device is configured to print at least one file from said at least one handheld mobile device only after receiving necessary configuration information, and wherein said LAN and said WAN network operate using non-homogeneous communication protocol ... wherein the directory server message processor is configured for automatically registering identification information for the at least one printing device on the directory server without intervention by an administrator, wherein the identification information at least partially comprises availability information and configuration information ... [and] wherein said at least one handheld mobile device is configured to send a discrete request to the directory server, said discrete request comprising an availability inquiry about the printing-availability of said at least one printing device," nor does the Examiner suggest they do.

The Examiner admits that Spinks does not involve a directory server message processor is configured for automatically registering identification information for the at least one printing device on the directory server without intervention by an administrator. The Applicants agree. However, the Examiner cites Rendezvous to allege that the above-mentioned limitation is well-known. The Applicants disagree with the Examiner's conclusion.

However, to expedite prosecution, the Applicants amend the Claims to distinguish Rendezvous. More particularly, the Application amend Claim 1 to recite "wherein said LAN and said WAN network operate using non-homogeneous communication protocol ... [and] wherein said at least one handheld mobile device is configured to send a discrete request to the directory server."

As explained in the originally-filed application, two drawbacks of the Rendezvous system include: (1) the fact that it did not work on non-LAN networks, and (2) that it requires continuous transmission by connected devices.

On the other hand, the Applicants recite a system that involves automatic registration of devices on a non-LAN network without intervention by an administrator using a non-homogeneous communication protocol and wherein the devices, *i.e.* a mobile device and printer, send *discrete* messages rather than continuous transmission.

For at least this reason, Claims 1, 3, 5-8, and 11-13 are not rendered obvious by a hypothetical combination of Spinks, Trossen, Hall, and Rendezvous.

For the record, the Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on Official Notice, and any other assertions of what is well known or commonly known in the prior art.

The foregoing amendments are made solely in the interest of expediency, in recognition of the Office policy of compact prosecution. They do not indicate agreement by Applicant with the Office's position, nor do they reflect intent to forsake Claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it is reasonably entitled to in future submissions to the Office.

### CONCLUSION

Applicant respectfully posits that the pending claims have been distinguished from the art of record, and that all objections to and rejections of the claims have been overcome. Accordingly, Applicant respectfully requests allowance. Should the Examiner deem it helpful he is encouraged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,



Michael A. Glenn

Reg. No. 30,176

Customer No. 22862